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Satoru Suzuki

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05/07/2007

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP

901 NEW YORK AVENUE, NW  
WASHINGTON, DC 20001-4413

EXAMINER

COLBERT, ELLA

ART UNIT

PAPER NUMBER

3694

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

09/815,422

Applicant(s)

SUZUKI ET AL.

Examiner

Ella Colbert

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 30-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 30-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-7 and 30-33 are pending. Claims 1-4, 6, 7, 30, and 32 have been amended in this communication filed 1/30/07 entered as Request for Continued Examination (RCE –After Final) and Request for Extension of Time.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/30/07 has been entered.

#### **Title Objection**

3. The title of the invention is objected to. The title of the invention should be "ELECTRONIC APPARATUS, CHARGE PROCESSING DEVICE, AND STORAGE MEDIUM".

#### ***Claim Objections***

4. Claims 1, 30, and 32 are objected to because of the following informalities: Claim 1 recites "function executing means for executing the functions;". This claim limitation should recite "function executing means for executing one of the plurality of functions including playback, recording, fast forwarding, and rewinding designated by the operating input means;". Claim 30 has a similar problem. Claim 30 should recite "used time measuring means based upon a result of the reception ..., ... which each of

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the plurality of functions, including playback, recording, fast forwarding, and rewinding has been executed. Claim 32, should recite "computing an amount of charge based upon the measured ... each of said plurality of functions, including playback, recording, fast forwarding, and rewinding." Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-7 and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,347,136) Horan in view of (US 5,956,697).

Claim 1. Horan discloses An electronic apparatus comprising: operation inputting means for designating one of a plurality of functions including playback, recording, fast forwarding, and rewinding (col. 3, lines 35-60); and function executing means for executing the functions (col. 3, lines 35-60).

Horan failed to disclose, measuring means for measuring the time during which each of said functions has been executed by said function executing means; and chargeable amount computing means for computing a chargeable amount based on the execution time measured by said measuring means regarding each of said functions. Usui discloses, measuring means for measuring the time during which each of said functions has been executed by said function executing means (col. 4, lines 25-55); and

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chargeable amount computing means for computing a chargeable amount based on the execution time measured by said measuring means regarding each of said functions (col. 5, lines 9-51). In treatment of the last limitation quoted above regarding a chargeable amount computing means computes said chargeable amount based on the execution time regarding each of said functions and through weighting on a function-by-function basis. It would have been obvious to one having ordinary skill in the art to modify Horan as taught by Usui to know how much time has been spend using each function and to know the amount of expected payment based on the charge for each function.

Claim 2. Horan failed to disclose, An electronic apparatus according to claim 1, wherein said computing means computes said amount of charge based on the execution time regarding each of said functions and through weighting on a function-by-function basis. Usui discloses, An electronic apparatus according to claim 1, wherein said computing means computes said amount of charge based on the execution time regarding each of said functions and through weighting on a function-by-function basis (col. 2, lines 15-51). It would have been obvious to one having ordinary skill in the art to modify Horan as taught by Usui to calculate the fee for access according to the length of time each device is connected to the client or other network device.

Claim 3. Horan failed to disclose, An electronic apparatus according to claim 2, wherein said function executing means is controlled by a microprocessor, and wherein said computing means computes said amount of charge based on the execution time regarding each of said functions and through weighting by a load factor of said

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microprocessor in effect during execution of each of said functions. Usui discloses, An electronic apparatus according to claim 2, wherein said function executing means is controlled by a microprocessor, and wherein said computing means computes said amount of charge based on the execution time regarding each of said functions and through weighting by a load factor of said microprocessor in effect during execution of each of said functions (col. 3, line 61-col. 4, line 10). It would have been obvious to one having ordinary skill in the art to modify Horan as taught by Usui to have a microprocessor for loading the devices and be able to charge for the execution of each device by an account charging unit.

Claim 4. Horan discloses An electronic apparatus according to claim 2, wherein said chargeable amount computing means computes said chargeable time based on different weighting factors set for different apparatuses (col. 3, line 61-col. 4, line 15).

Claim 5. Horan discloses An apparatus according to claim further comprising: storing means for storing execution times for each of said functions measured by said measuring means (col. 4, lines 16-57); and transmitting means for transmitting said execution times from said storing means to an external entity for settlement of charges (col. 6, lines 24-36).

Claim 6. Horan failed to disclose, An electronic apparatus according to claim 1, further comprising: storing means for storing a chargeable time representing the amount of charge computed by said computing means; and transmitting means for transmitting said chargeable time from said storing means to an external entity for settlement of charges. Usui discloses, An electronic apparatus according to claim 1, further

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comprising: storing means for storing a chargeable time representing the amount of charge computed by said computing means (col. 4, lines 5-10 and col. 5, lines 16-53); and transmitting means for transmitting said chargeable time from said storing means to an external entity for settlement of charges (col. 3, lines 26-49). It would have been obvious to one having ordinary skill in the art to modify Horan as taught by Usui to have a fee-charging server that checks the access time of each device and stores the amount of time for later reconciliation of the amount of the charge (fee).

Claim 7. Horan failed to disclose, An electronic apparatus according to claim 1, further comprising: storing means for storing a usable time of said apparatus; and settling means for subtracting a chargeable time representing the chargeable amount computed by said chargeable amount computing means, stored in said storing means, from said usable time stored in said storing means. Usui discloses, An electronic apparatus according to claim 1, further comprising: storing means for storing a usable time of said apparatus (col. 2, lines 24-43 –Summary of Invention); and settling means for subtracting a chargeable time representing the chargeable amount computed by said chargeable amount computing means, stored in said storing means, from said usable time stored in said storing means (col. 1, lines 49-67-Background of the Invention). It would have been obvious to one having ordinary skill in the art to modify Horan as taught by Usui to have the capability to settle the account by performing a mathematical process to arrive at an account settlement for each function's usage.

Claim 30. This independent claim is rejected for the similar rationale as given above for claims 1 and 6.

Claim 31. This dependent claim is rejected for the similar rationale as given above for claims 5 and 6.

Claim 32. This dependent claim is rejected for the similar rationale as given above for claims 1-3.

Claim 33. This dependent claim is rejected for the similar rationale as given above for claim 6.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7 and 30-33 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-7 and 30-33 of copending Application No.'s 11/390,207; 11/390,208; 11/390,375; 11/390,376; 11/390,383; 11/390,453; and 11/390,454. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.



The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: essentially the same invention as the instant application 09/815,422 except for "the playback, recording, fast forwarding, and rewinding" elements.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Response to Arguments***

8. Applicant's arguments with respect to claim 1-7 and 30-33 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Henderson (US 7,142,846) disclosed replay and recording messages.

Schweitzer et al (US 6,418,467) disclosed an accounting and billing system for function usage.

### ***Inquiries***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741.


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The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

April 30, 2007

  
ELLA COLBERT  
PRIMARY EXAMINER